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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/825,969 | 04/04/2001 | Thomas D. Doerr | 951130.90029 | 5575 |
| 26710 | 7590 | 05/31/2006 | EXAMINER | |
| QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497 | | | PORTER, RACHEL L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,969

Applicant(s)

DOERR ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 3/17/06. Claims 1-9, and 11-22 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

[claim 11]

Claim 11 recites "the point-of-care of care decision support system of claim **10**..." However, claim 10 has been cancelled. Therefore it is chain of dependency for claim 11 is unclear. For the purpose of applying art, the Examiner will interpret claim 11 as being directly dependent from claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-12 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (USPN 5,924,074).

[claim 1] Evans discloses a decision support system comprising:

- a hand-held terminal usable during examination and providing a display and physician input device; (see Abstract, col. 2, lines 47-50; col. 5, lines 8-21)
- a terminal server communicating with the hand-held terminal and executing a stored program to:
 - o present on the display of the hand-held terminal a navigation menu presenting diagnosis codes representing different medical diagnoses; (Fig. 20; col. 11, lines 37-50)
 - o accept from the physician input device of the hand-held terminal a selection

identifying a specific diagnosis code from the diagnosis codes; and (col. 11, lines 37-50)

- enable physician access to additional physician support features related to a treatment of a medical diagnosis represented by the specific diagnostic code. (col. 11, lines 54-60; Figures 18, 20—procedures/treatments provided relating to diagnosis and diagnosis code; medication manager also available)

[claim 4] Evans teaches a decision support system wherein physician support features include display of physician educational information related to at least one of the diagnosis and treatment. (Figures 18,20; col. 11, lines 10-30; 37-54)

[claim 5] Evans teaches a support system wherein additional physician support features include hyperlinks to physician educational information. (Figure 14,24; col. 13, lines 20-30)

[claim 6] Evans teaches a decision support system wherein the terminal server further accepts from the physician input device of the hand-held terminal a selection identifying a specific patient, (col. 6, lines 55-63) and wherein the additional physician support features include display of a history of related diagnoses and treatments for the patient. (col. 6, line 62-col. 7, line 40; Figures 7-8)

[claim 7] Evans teaches a support system wherein the display of a history of related diagnoses and treatments for the patient includes identification of at least one medication used in the treatment. (col. 7, lines 41-52)

[claim 8] Evans teaches a system wherein the diagnosis codes are codes of the

international Classification of Diseases developed by the World Health Organization. (Figure 14; col.9, lines 4-7)

[claim 9] Evans teaches a support system wherein the selection is a direct selection of a diagnosis code displayed by the navigation menu. (col. 11, lines 46-50)

[claim 11] Evans teaches a support system wherein the navigation menu displays linked diagnosis codes and treatment options and the selection is a direct selection of a treatment option. (Figure 20; col. 11, lines 27-30) (See 112, 2nd paragraph rejection for claim 11)

[claim 12] Evans teaches a decision support system wherein the additional physician support features include a listing of treatment options related to the specific diagnosis code. (col. 11, lines 14-22—lists medications that may correspond with a diagnosis)

[claim 14] Evans teaches a decision support system wherein additional physician support features include a listing of procedure options related to the specific drugs. (col. 11, lines 27-30)

[claim 15] Evans teaches a support system, which include access to a searchable database of drugs. (Figures 21-22; col. 12, lines 6-25)

[claim 16] Evans teaches a system wherein the terminal server and the hand-held terminal provide interfaces connecting to the Internet and wherein the terminal server connects with the hand-held terminal via the Internet. (col. 12, lines 56-63; col. 13, lines 13-30)

[claim 17] Evans teaches a support system which provides wireless communication among the devices (i.e. between the hand-held terminal and the terminal server) (col. 2, lines 45-50; col. 13, lines 13-30)

[claim 18] Evans teaches system wherein system wherein the physician input device includes a keyboard or stylus entry device (col. 7, lines 10-14)

[claim 19] Evans teaches a decision support system wherein the display is a graphic display providing for the display of text and images. (Figure 8; col. 7, lines 11-40)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and further in view of Denny (USPN 6,687,676)

[claims 2-3] Evans discloses a decision support system, as explained in the rejection of claim 1. Evans further discloses that the system provides additional physician support tools (col. 7, lines 41-64), but does not expressly disclose that the system prints patient handouts related to the diagnosis or treatment and printing a prescription for treatment. Denny discloses a system, which prints a prescription for the patient (i.e. a handout related to treatment and a prescription for treatment) (col. 6, line 51-59). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Denny to provide patient handouts related to treatment and printouts of a prescription for treatment. As suggested by Denny, one would have been motivated to include this feature to ensure that the patient given proper dosage and special instructions for treatments (col. 1, lines 42-55) and to facilitate the retrieval and fulfillment of a prescription at a patient-selected

pharmacy (col. 7, lines 6-13)

9. Claims 13, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 1 above, and further in view of Mayaud (USPN 5,845,255)

[claim 13] Evans discloses a decision support system that provides navigation menu lists of diagnosis codes and treatment codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis and treatment codes are listed by the frequency of prior use by a particular physician or group of physicians. Mayaud discloses an adaptive system in which treatments (i.e. prescribed drugs) may be displayed based upon frequency of use (i.e. how often they are ordered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Mayaud to display treatment information based upon the frequency with which it is used by the physician(s). As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

[claims 21-22] Evans discloses a decision support system that provides navigation menu lists of diagnosis codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis codes are listed by the frequency of prior use by a particular physician or group of physicians. Mayaud discloses an adaptive system in which

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disease conditions may be displayed based upon frequency of use (i.e. how often they are encountered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans with the teaching of Mayaud to display diagnosis information (e.g. codes/conditions) based upon the frequency with which it is encountered by the physician(s) using the system. As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

10. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans as applied to claim 19 above, and in view of Lee ("Fujitsu Pen Computer Will Ship with Windows 95").

[claim 20] Evans teaches a decision support system as explained in the rejection of claim 19. Evans further discloses that the display of the system is a graphic display providing for the display of text and images (Figure 8; col. 7, lines 11-40), but does not specifically disclose the resolution of the system display. Lee discloses the use of higher resolution displays (e.g. resolution of at least 600 x 200) to view data on handheld computers. (page 1, par. 6) At the time of the Applicant's invention it would have been obvious to one of ordinary skill in the art to combine the system of Evans with the teaching of Lee include the use of a higher resolution handheld display unit in the system of Evans. As suggested by Evans, one would have been motivated to include this feature to improve the detail displayed in the graphical images (e.g. x-rays)

(col. 7, lines 34-40; col. 13, lines 13-20), thereby increasing the accuracy of diagnoses made through such images.

Response to Arguments

11. Applicant's arguments filed 3/17/06 have been fully considered but they are not persuasive.

(A) Applicant argues that Evans reference does not teach the conditional access to a reference database.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enable access to the references database being conditional on the entry of a diagnosis code/ only after identification of the specific diagnosis code) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the current claim language fails to define how the identification of a specific code denies or permits access to the additional features. In other words, the Applicant argues that the physician can gain access to these support features only by selecting an appropriate diagnosis code. Yet, the current claim language recites presenting diagnosis codes with diagnoses on a navigation menu; accepting the selection of a diagnosis code from physician input device; and enabling physician

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access to additional support features. It should be noted that the step of “enabling physician access” does not even require an additional active step.

In other words, access to other support features has been “enabled” by allowing the physician to perform the other two steps recited. It is not clear that any data is presented to the physician, nor is the “enable physician access” step recited as a conditional step.

Furthermore, the Examiner submits that the Applicant fails to realize the breadth of the current claim language. The phrases “additional physician support features” (claim 1) and “physician educational information related to at least one of diagnosis and treatment...” (claim 4) are broad and may include any information used by the physician to aid in the treatment or diagnosis of the patient. (e.g. legacy patient records, treatment look-up, diagnosis description look-up; medication manager) As the applicant did not provide a specific definition for these terms in the claims or in the originally filed disclosure, the Examiner must give them the broadest reasonable interpretation.

(B) Applicant argues that the Mayaud and Denny references teach away from and do not remedy the shortcomings of the Evans reference.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant again argues that neither Mayaud nor Denny disclose a system wherein access to additional physician support is condition upon the input of a specific diagnosis code. However, it is noted that the features upon which applicant relies (i.e., enable access to the references database being conditional on the entry of a diagnosis code/ only after identification of the specific diagnosis code) are not recited in the rejected claim(s).

Conclusion

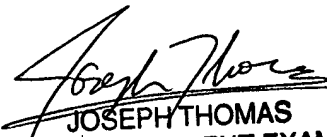
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP
RP


JOSEPH THOMAS
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